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December 21, 2005

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MARK Bourgeois

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12/21/2005

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial no.: 09/939,491  
Filing date: 08/24/2001  
For: Clematis Plant named 'Avalanche'  
Inventor: White  
Atty. Docket no.: PH41  
Group Art Unit: 1655  
Examiner: McCormick

### Appeal Brief

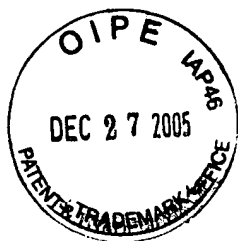
This is in response to the Notice of Appeal mailed on December 14, 2005.

Applicant hereby submits the enclosed Appeal Brief to the Board of Patent Appeals and Interferences.

Since an appeal brief was previously submitted along with an appeal brief small entity fee of \$160 and the present appeal brief small entity fee is \$250, the Commissioner is authorized to charge the difference between the previously paid fee and the current fee of \$90 to Deposit Account number 50-2485.

Respectfully submitted,

Mark P. Bourgeois  
Reg. No. 37,782



## **APPEAL BRIEF**

### **Real Party in interest**

The real party in interest in the present appeal brief is Anthony Robin White.

### **Related Appeals and Interferences**

There are no related appeals or interferences.

### **Status of Claims**

Claim 1 is pending. Claim 1 was finally rejected under 35 U.S.C. 102b as being unpatentable over Plant Breeders Rights certificate number 4711 in the European Community in view of sales in the United Kingdom in the Fall of 1998. The final rejection of claim 1 is being appealed.

### **Status of Amendments**

There are no amendments that have not been entered.

### **Summary of Invention**

The invention is a Clematis plant named 'Avalanche'. The invention is exemplified in claim 1, which recites the new and distinct variety of Clematis plant named 'Avalanche' as described and illustrated.

Support for this is found in the specification on pages 1-7 and is shown in figures 1-3.

**Issues**

Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of plant breeders right publication number 4711 in the European Community and being on sale in the United Kingdom.

**Grouping of Claims**

For each ground of rejection, which appellant contests herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

**Argument**

**Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of plant breeders right publication number 4711 in the European Community and being on sale in the United Kingdom.**

Independent claim 1 recites a new and distinct variety of Clematis plant named 'Avalanche' as described and illustrated.

The Examiner has noted that the variety that is the subject of this application has previously been protected by a plant breeder's rights certificate in one or more foreign countries. The Examiner further noted that the referenced plant breeder's rights certificate was published more than one year prior to the filing date of this plant patent application in the United States. The Examiner has used 37 CFR 1.105 to request information from the Applicant regarding whether the variety was publicly available

anywhere in the world prior to the filing date of the present application. The Examiner cites *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (BPAI 1992) as authority for this request for information.

In the requests for information under 37 CFR 1.105 dated June 18, 2002 and April 15, 2005, the Office requested the Applicant to provide copies of the plant breeders rights application, proposed denomination and grant. The Office stated that copies of these documents are not readily obtainable.

If these documents are not readily obtainable by the U.S. Patent Office that has access to a vast array of resources, why would they be available to an isolated plant breeder?

It is doubtful that a plant breeder would readily be able to obtain copies of plant breeders right publication number 4711 and obtain specimens of Clematis Avalanche that were only available in the United Kingdom and successfully reproduce Clematis Avalanche prior to the filing date of the present application.

The public use and availability of the subject plant variety outside of the United States is not material to a determination of "plant patentability" of a plant variety in the United States under 102b.

The examination strategy set forth by the Examiner results in a denial of plant patent protection in the United States based upon prior art which does not make the plant variety available or accessible to the American public, and frustrates the intent of U.S. patent law. It is the Applicant's belief that the Federal Circuit will not support any

rejection based on such an examination policy.

The Examiner cites *Ex parte Thomson*, 24 USPQ 2d 1618, 1620 (BPAI 1992) to support the contention that a printed publication describing a new asexually reproducible plant variety, combined with the availability of the variety anywhere in the world, is sufficient to bar "plant patentability" of the variety under 35 U.S.C. 102(b).

The *Ex Parte Thomson* board admits that the printed publications cited were not, in and of themselves, enabling, and attempts to make those references enabling by combining them with the public availability of the cotton seeds in Australia. A non-enabling printed publication by itself cannot be cited as prior art under 102(b). Foreign public use alone cannot be cited as prior art under 102(b). *Ex Parte Thomson* combined these two non-prior art references.

It is improper to rely on a combination of references to anticipate the claimed invention under 35 U.S.C. 102(b). *Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc.*, 726 F.2d 724, 726 (Fed. Cir.1984). Anticipation must be found in a single reference. It is proper to cite an additional reference in making a rejection under 35 U.S.C. 102(b) only to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public. See *Application of Samour*, 571 F.2d 559, 565 (CCPA 1978).

*Ex Parte Thomson* represents an improper use of 102(b) to deny utility patent protection for a plant variety based upon prior art references which do not make the invention available to the American public.

Title 35 U.S.C. 102(b) reads, in pertinent part:

A person shall be entitled to a patent unless  
 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .

If an invention has been in widespread public use in France for the last 30 years, but is not the subject of any printed publication, then the original inventor has every right to file for and obtain patent protection in the United States. Section 102(b) expressly allows such a result. The foreign use of the invention is not deemed to have made the invention available to the American public. It is immaterial to any 102(b) analysis that the French public may have had the invention for the last 30 years.

How does the American public get access to a plant invention? In order for the American public to access, use and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be reproduced.

Foreign asexually propagatable plant material, unlike the information in a printed publication, is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States. The quarantine act imposes rigorous importation requirements.

The court in *In re LeGrice* established a perfectly workable and rational approach for applying the policy and the language of 102(b) to this unique situation. The *In re LeGrice* case was concerned with whether or not foreign plant varieties are actually available to the American public, and acknowledged that at some future point in time, a mere printed publication might enable a person to make a genetic duplicate, or clone, of a particular plant without access to the plant material itself. That day is not here yet.

The *LeGrice* court disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Under 35 U.S.C. 102(b), an invention is not patentable if it was described in a printed publication, in this or a foreign country, more than a year prior to the filing date of the U.S. application. In order for a printed publication to serve as a reference under 35 U.S.C. 102(b), it must enable the invention. *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985). A written description of a plant variety is simply not enabling. Plant patents have always been exempt from the Section 112 written enablement requirement which applies to all utility patents. A particular plant cannot be reproduced by reference only to a printed publication alone. Congress acknowledged this concept when the Plant Patent Act of 1930 was drafted.

A non-enabling publication fails as a reference under 102(b). Foreign public or commercial activity also fails as a barring activity under 102(b). Combining these two “non-references” to make a rejection under 102(b) is not logical.

The unique and very narrow scope of protection offered by a plant patent has a direct impact on the scope of prior art that can be properly considered in determining the patentability of a new plant variety. Because a plant patent cannot be infringed without access to the new plant or its asexual progeny, a new plant variety cannot be anticipated without direct access by the American public in the United States to the new plant or its asexually reproduced progeny.

In the case of a plant patent, propagatable material of the new variety is not only essential to enable the invention. It is the invention. In the absence of propagatable

material, the variety does not exist, nor can it be conjured up from the description in any printed publication, regardless of how detailed or specific. In the absence of any publicly available asexually propagatable plant material in the United States, no plant variety can, at the present level of technology, be anticipated by a mere printed publication, regardless of how detailed it is, and regardless of where it is published.

For the foregoing reasons, the Applicant asserts that the cited Plant Breeder's Rights Certificate is not a bar to patentability of the claimed new variety under 35 U.S.C. 102(b), because of the difficulty in obtaining the publication and that propagatable material of the variety was not available in the United States.

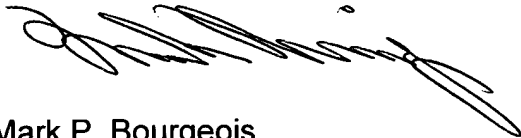


**Conclusion**

It has long been the practice of the U.S. Patent & Trademark Office to disregard the existence of foreign Plant Breeder's Rights certificates in determining patentability of a new plant variety. Additionally, the USPTO has never before considered foreign publication, use, or sale of a new plant variety to be a bar to patentability in the United States. The availability of U.S. plant patent rights has encouraged the importation of many valuable foreign varieties into the United States for commercial exploitation by U.S. growers.

For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,



Mark P. Bourgeois  
Reg. No. 37,782

**Appendix**

The claims involved in the appeal follow below:

1. A new and distinct variety of Clematis plant named 'Avalanche' as described and illustrated.